

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Frederick J. Murphy	Examiner:	Rogers
Serial No:	09/877,238	Art Unit:	2626
Filed:	June 11, 2001		
Publication:	US 2002/0036791 A1, published March 28, 2002		
Title:	Method and Apparatus for Interfacing a Plurality of Devices to a Computer Network		

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.181(a) and 37 CFR 3.73(b)
FOR DECLARATION AS TO TYPE OF APPLICATION

Applicant/inventor Frederick J. Murphy respectfully requests that the Director determine whether the above-captioned application (hereafter “the ‘238 application”) has been correctly designated a “*divisional application*,” as indicated on the face of corresponding published application US 2002/003679 A1, or whether it is actually in fact a “*continuation-in-part application*” based on added subject matter included in the ‘238 application but not found in the prior application. 35 U.S.C. 120; 37 CFR 1.53(b). Applicant/inventor seeks this determination to clarify whether he retains the right, initially vested in the inventor, to take action in the instant patent application. Although a prior assignment recorded against an original application would be applied to a divisional application, a continuation-in-part application requires a new assignment, and no new assignment has ever been executed or recorded in the present case. 37 CFR 3.73(b); MPEP 306, 324(II).

This petition is appropriately submitted to the Director in keeping with the mandate of Rule 3.73(b) that the right of an assignee to take action be established to the satisfaction of the Director. 37 CFR 1.181(a)(2), 1.181(a)(3).

REMARKS

In the present petition, the Director is asked to determine whether the '238 application was correctly designated a *divisional application* (as indicated on the face of corresponding published application US 2002/003679 A1; Exhibit A hereto), or whether it is in fact a *continuation-in-part application* because it contains subject matter not found in the prior application. 35 U.S.C. 120; 37 CFR 1.53(b).

For the convenience of the Director, this Petition is accompanied by the following exhibits:

- | | |
|------------|--|
| Exhibit A: | Published application US 2002/0036791 A1, published March 28, 2002 (corresponding to application 09/877,238, filed June 11, 2001), " <i>Method and Apparatus for Interfacing a Plurality of Devices to a Computer Network</i> " |
| Exhibit B: | Prior application 09/506,925, filed February 18, 2000, " <i>Internet Global Area Networks Fax System</i> " (hereafter "the '925 application") |
| Exhibit C: | " <i>Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address</i> " executed by the inventor, Mr. Murphy, and filed with the U.S. Patent & Trademark Office by express mail on July 29, 2004. |
| Exhibit D: | Assignment of US application 08/855,911, recorded November 4, 1996 |

Procedural Background

1. On information and belief, the '925 application was filed on February 18, 2000, as a divisional application of US 09/184,972, filed November 3, 1998, now US Patent No. 6,028,679, issued February 22, 2000, which is a divisional of application serial no. 08/855,911, filed November 13, 1995.

2. On information and belief, the '238 application was published on March 28, 2002, as US Published Application US 2002/0036791 A1. The 'related application' data shown on the first page of the published application indicates that the '238 application claims benefit from the '925 application as a divisional application. A copy of US Published Application US 2002/0036791A1 is attached hereto as Exhibit A.

3. On July 21, 2004, the undersigned, as representative for the inventor, Mr. Murphy, ordered and obtained a copy of the prosecution file wrapper for the '925 application from the US Patent & Trademark Office (hereafter "the Office"). The file wrapper included a copy of the '925 application as filed. A copy of the transmittal papers, specification, and drawings of the '925 application that were obtained from the Office is attached hereto as Exhibit B.

4. A "*Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address*" form was executed by the inventor and filed with the Office by express mail on July 29, 2004 (hereafter "Revocation and Power of Attorney", Exhibit C hereto), for the purpose of filing the instant petition and seeking the Director's review.¹

¹ Applicant's prior representative, Mr. Peterson, was provided with a copy of the Revocation and Power of Attorney by facsimile transmission on August 4, 2004.

5. On information and belief, an assignment was recorded against parent application 08/855,911 at reel/frame 008316/0076, and given an effective recordation date of November 4, 1996 (hereafter "the 1996 Assignment Document", Exhibit D hereto). The 1996 Assignment Document appears on its face to be a conveyance from Mr. Murphy to NetFax Incorporated of title to prior application 08/855,911, filed November 13, 1995.

Type of Continuing Application under 37 CFR 1.53(b)

Applicant/inventor respectfully requests that the Director compare the disclosure of the '238 application with the disclosure of the '925 application, and make a determination as to what type of continuing application should be listed in the 'related application' data for the '238 application. Applicant/inventor submits that the '238 application includes subject matter not found in the '925 application, and thus departs substantially from the rule that the disclosure of a divisional application not include new subject matter. MPEP § 201.06. In particular, the undersigned representative of the inventor recently compared the specification and drawings of the '238 application with the specification and drawings the '925 application. Although the benefit claims published on page one of the '238 application represent that it is a divisional application of the '925 application, the published version of the '238 application includes a substantial amount of subject matter not found in the '925 application. (By way of example, the '238 application has forty-seven figure drawings, while the '925 application has only nine figure drawings. Added subject matter is also present in the specification of the '238 application. *See*, Exhibits A and B hereto.)

The departure of the disclosure of the '238 application from the disclosure of the '925 application does not comply with the rules for filing divisional applications. 37 CFR 1.53(b); MPEP 201.06 (*"A "divisional" application is a later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application. The disclosure of a divisional application may not depart from the substance of the prior application by including new subject matter."*) Nor does the '238 application comply with the requirements of a regular continuation application. MPEP 201.07 (*"The disclosure presented in a continuation application must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application."*) In contrast, a "continuation-in-part" is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier application and adding matter not disclosed in the earlier application. MPEP § 201.08. A "continuation-in-part" is the proper designation for a later application that includes any amount of newly added subject matter.

Assignment

In view of the fact that a prior assignment recorded against the original application is applied to a divisional or a continuation application while a continuation-in-part application requires a new assignment, the determination sought by this petition would further identify which party has the right to take action in prosecuting the '238 application before the Office. MPEP 306. In the present case, although the 1996 Assignment Document allegedly conveyed title to parent application 08/855,911, there is no new assignment relating to the '238 application. A

decision by the Director to determine that the '238 application is, *de facto*, a continuation-in-part application due to its added subject matter would mean that the right to take action before the Office resides with the inventor.

Disclosure Under 37 C.F.R. 1.56

In keeping with Applicant's duty of candor and good faith, the undersigned attorney, on behalf of applicant/inventor Frederick J. Murphy, wishes to inform the Director of the following:

Bankruptcy Proceedings

NetFax Incorporated (the assignee of record of original parent application US serial no. 08/855,911) filed a voluntary petition for relief under Chapter 11 of the United States Bankruptcy Code on May 14, 2002, in the United States Bankruptcy Court for the District of Maryland (the "Bankruptcy Court"), Case Number 02-57777-SD. On or about June 21, 2002, the Bankruptcy Court converted the case to a Chapter 7 proceeding. The Chapter 7 trustee filed a motion in the Bankruptcy Court seeking authority to sell certain intellectual property allegedly owned by Netfax, including the '238 application. The Bankruptcy Court has granted the inventor relief from the automatic stay to permit him to file this petition. The applicant/inventor respectfully submits that, as a continuation-in-part application, title to the '238 application would not be held by the Netfax bankruptcy estate.

Filing of "Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address"

Having observed that the '238 application includes subject matter not disclosed in the prior '925 application, the applicant/inventor has a reasonable and good faith basis for believing

that he holds title to the '238 application, and thus has a right to take action in the current application. On that basis, a "*Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address*" form was executed by the inventor and filed with the Office by express mail on July 29, 2004 (hereafter "Revocation and Power of Attorney", Exhibit C hereto), for the purpose of filing the instant petition and seeking the Director's review.

Notwithstanding the above, the applicant/inventor wishes to inform the Office that, with the exception of the instant petition, no amendment or other submission or action has been taken by it in the present case, no contact has been made or attempted directly with the Examiner, and no attempt has been made to alter the claims or subject matter of the application. The applicant/inventor will continue to refrain from taking any further action in the '238 application while this Petition is pending, unless events arise that would render such an action essential to avoiding abandonment of the application or preserving its status quo.²

² On August 4, 2004, the Chapter 7 trustee for the Netflix bankruptcy estate sent a letter to counsel for the applicant/inventor alleging that the Revocation and Power of Attorney were a violation of the automatic stay. The applicant/inventor and his counsel responded to the trustee denying that these actions were a violation of the automatic stay but agreed, in the interest of moving toward a determination of title to the application that is not distracted by extraneous issues, that counsel for the applicant/inventor would file, without prejudice, a request to withdraw as attorney under 37 CFR Part 10. As part of the relief requested in the motion to lift stay, the applicant/inventor sought and obtained authorization to proceed with this petition and to take all actions necessary to effectuate and facilitate the filing of the petition (including filing a new power of attorney).

CONCLUSION

For all of the reasons discussed above, the Director's determination as to whether the '238 application is a divisional application versus a continuation-in-part application is respectfully requested.

Please charge the petition fee pursuant to 37 CFR 1.17(h) in the amount of \$130.00, and any remaining outstanding fees or overpayments, to Deposit Account No. 50-1895, Ref. No. 0503-002US2.

Respectfully submitted:

Date: _____

Leslie Meyer-Leon
Reg. No. 37,381

IP LEGAL STRATEGIES GROUP P.C.
P.O. Box 1210, 1480 Falmouth Road
Centerville, MA 02632-1210
Telephone: 508-790-9299
Facsimile: 508-790-1955

Enclosures: Exhibits A-D,
Check, and Postcard